

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBASISH BANERJEE and KENTAROH NOJI

Appeal 2007-0914
Application 09/904,734
Technology Center 2100

Decided: September 5, 2007

Before JAMES D. THOMAS, JOHN C. MARTIN,
and ST. JOHN COURTENAY, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-27. We have jurisdiction under
35 U.S.C. §§ 6(b) and 134(a).

Independent claims 1 and 12 are reproduced below as best
representative of the disclosed and claimed invention:

Claim 1. A method of determining an appropriate character set for use in client-server communications, comprising at least one of:

(a) selecting a character set for a client request made by client to a server using a network communication protocol, the selecting comprising:

determining whether the client request includes, as part of the network communication protocol, a request character set designation; and

if the client request does not include the request character set designation:

(i) retrieving locale information contained in the client request; and

(ii) associating the locale information with the request character set designation using mapping data located on the server; and

(b) selecting a response character set for a response from the server to the client, the selecting comprising:

determining whether the server response includes a response character set designation: and

if the server response does not include the response character set designation:

(i) retrieving locale information contained in the server response; and

(ii) associating the locale information contained in the server response with the response character set designation using the mapping data.

Claim 12. A server computer system connected to at least one client computer, the server computer system comprising a memory containing a code-set program and at least one processor, wherein the processor, when executing the code-set program, is configured to:

determine if a request header composed according to a network communications protocol received with a client request from the at least one client computer designates a character set; and

if the request header does not designate the character set:

(i) retrieve locale information from the client request; and

(ii) associate the locale information with a character set.

The following references are relied on by the Examiner:

Watanabe	US 6,185,729 B1	Feb. 6, 2001
Veditz	US 6,496,793 B1	Dec. 17, 2002 (filed Apr. 21, 1993)
Horn	US 2002/0156688 A1	Oct. 24, 2002 (filed Feb. 21, 2001)
Kan	US 2003/0088544 A1	May 31, 2003 (filed May 31, 2001)

Claims 1-27 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner relies upon Veditz and Watanabe for the first stated rejection of claims 1, 3-5, 7-9, 12-14, 16, 18-20 and 22-24. Veditz and Watanabe are combined with Horn in the second stated rejection of claims 2, 6, 10, 11, 17¹, 21, 26 and 27. Veditz and Watanabe are combined with Kan for the third stated rejection of claims 15 and 25.²

¹ We note that claim 17 depended from claim 16 in the originally filed claims, but was changed to depend from claim 1 in the claims filed 11/22/2004. However, the change was not marked, and would have resulted

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for the Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

We affirm.

Of independent claims 1, 12, and 16 included within the first stated rejection under 35 U.S.C. § 103(a), Appellants only present arguments to these independent claims collectively, and present no separate arguments to the remaining dependent claims encompassed by this rejection. Additionally, the Examiner rejected independent claims 12 and 16 "along the same rationale" as claim 1 (Answer, 6). We will address independent claim 12 separately and independent claims 1 and 16 collectively.

Initially, we note that Appellant has presented no arguments directed to the combinability of Watanabe, Horn, or Kan with Veditz or each other. Accordingly, Appellants have waived any such arguments, and the combinability of the references will not be addressed here.

in claims 2 and 17 being identical claims. The claim has been treated as though it depends from claim 16, since this appears to be a typographical error.

² The Brief incorrectly lists the grounds of rejection for claims 15 and 25 as Veditz in view of Kan (Br. 9), as was done at page 11 of the Final Rejection of 9/19/2005. However, Appellants correctly noted that the rejection was intended to rely on Veditz, Watanabe and Kan (Br. 15), and the grounds of rejection was corrected by the Examiner in the Answer (Answer, 11).

Regarding the rejection of independent claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Veditz and Watanabe, Appellants argue that Veditz and Watanabe fail to disclose a computer program configured to “determine if a request header composed according to a network communications protocol received with a client request from the at least one client computer designates a character set; and if the request header does not designate the character set: (i) retrieve locale information from the client request” (Br. 14-15). The Examiner points to the rejection of claim 1 (Answer, 6), which primarily relies on col. 3 of Veditz (Answer, 4-5).

We direct attention to Appellants' Specification, which appears to admit that all features of claim 12 were known in the art at the time the invention was made. Appellants admit that the HTTP specification contains an optional header that may contain character set information (Specification, ¶8). While the use of this header by a client is optional, a fully compliant HTTP server receiving an HTTP request must still determine if a request header (the Content-Type header) composed according to a network communications protocol (HTTP) received with a client request from the at least one client computer designates a character set. Appellants further admit that it is known to select a character set when the Content-Type header fails to specify a character set (Specification, ¶9). Appellants also admit that, upon determining that the client request does not designate a character set, a well known API, developed by Sun Microsystems, may be invoked to retrieve locale information from the client request in order to determine an associated character set (Specification, ¶35). In the context of these admissions, it is implicit to translate server locales to a character set,

particularly in view of the recognition in paragraph 9 of the Specification that it is known to select a character set when the Content-Type header fails to specify a character set. Therefore, we find the weight of the evidence shows that the subject matter of claim 12 was within the admitted prior art.

Regarding the rejection of independent claims 1 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Veditz and Watanabe, we note that claims 1 and 16 are Markush-type claims containing two alternative series of steps, (a) and (b). We further note that the series of steps in (a) substantially correspond to the steps performed by the computer program of claim 12. To the extent Appellants make reference to claims 1 and 16 at page 14 of the principal Brief, the Examiner addresses the preamble limitations relating to client-server communications in the statement of the rejection on page 6 of the Answer, as well as on pages 14 and 15 in the Examiner's responsive arguments. What Appellants do state at page 14 of the Brief about Watanabe is not disputed. However, Appellants fail to address what the Examiner says is pertinent to claims 1, 12, and 16 as it relates to all aspects of client-server communications. The Reply Brief fails to challenge the Examiner's findings with respect to Watanabe. A better context of the details of client-server communications is seen from our discussion of Appellants' admissions regarding client-server communications, as discussed *supra*.

Regarding admissions, our reviewing court has recently stated:

Accordingly, PharmaStem's argument that stem cells had not been proved to exist in cord blood prior to the experiments described in the patents is contrary to the representation in the specification that the prior art disclosed stem cells in cord blood. Admissions in the specification regarding the prior art

are binding on the patentee for purposes of a later inquiry into obviousness. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed.Cir.1988) (“A statement in the patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *Sjolund v. Musland*, 847 F.2d 1573, 1577-79 (Fed.Cir.1988) (patent specification admitted that certain matter was prior art, and thus “the jury was not free to disregard [that matter]” and “must have accepted [it] as prior art, as a matter of law”); *In re Fout*, 675 F.2d 297, 300 (CCPA 1982); *In re Nomiya*, 509 F.2d 566, 571 (CCPA 1975).

Nor is there any unfairness in holding the inventors to the consequences of their admissions, as their characterization of the prior art as showing the presence of stem cells in cord blood is hardly unreasonable.

PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1362, 83 USPQ2d 1289, 1303 (Fed. Cir. 2007).

Also, in an unpublished and non-precedential opinion, the Court of Appeals held that an inventor's admissions supported findings that claims were unpatentable as being obvious to one having ordinary skill in the art. *See In re Constant*, 10 Fed. Appx. 898, 899 (Fed. Cir. 2001), 2001 WL 502031.

Appellants have not presented any arguments directed separately to the patentability of dependent claims 3-5, 7-9, 13, 14, 18-20 and 22-24. Appellants have also failed to present any arguments directed to the second and third stated rejections of dependent claims 2, 6, 10, 11, 15, 17, 21 and 25-27. In the absence of separate arguments with respect to these dependent claims, those claims fall with their respective independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See*

also 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we sustain the Examiner's rejection of these claims for the same reasons discussed *supra* with respect to claims 1, 12 and 16.

In summary, we sustain each of the Examiner's separately stated rejections of claims 1-27 under 35 U.S.C. § 103(a). The rejections of these claims encompass all claims on appeal, and all rejections are affirmed. Therefore, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

MARTIN, *Administrative Patent Judge*, dissenting.

I respectfully disagree with the majority's decision to affirm the rejection of independent claim 12 on the ground that "Appellants' Specification . . . appears to admit that all features of claim 12 were known in the art at the time the invention was made." *Supra* p. 5. Specifically, I disagree with the majority's characterization of paragraph 35 of the Specification as "admit[ting] that, upon determining that the client request does not designate a character set, a well known API, developed by Sun Microsystems, may be invoked to retrieve locale information from the client request in order to determine an associated character set. (Specification, ¶35)." *Supra* p. 5. The only information in paragraph ¶ 35 that can be fairly treated as admitted prior art is the description of "ServletRequest.getLocale()" as an API that was developed by Sun

Microsystems for the purpose of extracting the locale from an HTTP request. The admitted prior art does not include (a) using that API to extract the locale if the “Content-Type” header does not contain a code-set identifier, as required by the claim, or (b) associating the thus-extracted locale with a character set, as also required by the claim. Instead, paragraph 35 attributes the use of the API in this manner to Appellants’ computer program 110. I also disagree with the majority’s statement that “[i]n the context of these admissions [in paragraphs 8, 9, and 35], it is implicit to translate server locales to a character set, particularly in view of the recognition in paragraph 9 of the Specification that it is known to select a character set when the Content-Type header fails to specify a character set.” *Supra* pp. 5-6. Paragraphs 8 and 9 do not cure the above-noted deficiencies of paragraph 35. That is, they do not indicate that it was known to (a) use the Sun Microsystems API or any other locale-extracting software to extract the locale if the “Content-Type” header does not contain a code-set identifier or (b) to associate the thus-extracted locale with a character set.

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For the foregoing reasons, I disagree with the majority's finding that the subject matter of claim 12, which is also recited as alternative (a) in claims 1 and 16), is admitted prior art.

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